REMARKS/ARGUMENTS

In the Office Action mailed September 21, 2007, claims 1-23 were rejected. In response, Applicants hereby request reconsideration of the application in view of the amendments and the below-provided remarks. No claims are added or canceled.

For reference, claims 1, 7, 12, and 18 are each amended to remove a reference to the conditional limitation related to a fullness condition of the FIFO. These amendments are supported by the subject matter of the originally filed application.

Claim Rejections under Nonstatutory Double Patenting

Claims 1, 7, 10, 12, 18, and 21 were <u>provisionally</u> rejected under the judicially created doctrine of double patenting. Specifically, the Office Action states that claims 1, 7, 10, 12, 18, and 21 of the present application are not patentably distinct from claims 9, 1, 3, 10, 4, and 6, respectively, of copending U.S. Patent Application No. 10/495,403 (hereinafter "the `403 Application"). Because the rejection is provisional, Applicants respectfully decline to submit a Terminal Disclaimer at this time.

Claim Rejections under 35 U.S.C. 112, first paragraph

Claims 1, 7, 12, and 18 were rejected under 35 U.S.C. 112, first paragraph, as purportedly failing to comply with the written description and enablement requirements. Specifically, the Office Action states that the claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Additionally, the Office Action states that the claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

In particular, the Office Action states that the claims fail to comply with the written description and enablement requirements because of the limitation "regardless of a fullness condition of the FIFO." Applicants submit that claims 1, 7, 12, and 18 are

amended to remove the indicated limitation. Accordingly, Applicants respectfully request that the rejections of claims 1, 7, 12, and 18 under 35 U.S.C. 112, first paragraph, be withdrawn.

Claim Rejections under 35 U.S.C. 102 and 103

Claims 1-23 were rejected under 35 U.S.C. 103(a) as being unpatentable over Robertson (U.S. Pat. No. 6,892,253, hereinafter Robertson) in view of Bender et al. (U.S. Pat. No. 5,664,223, hereinafter Bender). However, Applicants respectfully submit that these claims are patentable over Robertson and Bender for the reasons provided below.

Independent Claim 1

In regard to claim 1, Applicants respectfully submit that claim 1 is patentable over the combination of Robertson and Bender because the combination of cited references does not teach all of the limitations of the claim. Claim 1 recites "said control means is adapted to issue a first call for available room in said FIFO memory to said controller" (emphasis added). Since the control means is adapted to issue a first call to the controller, the control means is separate from the controller.

In contrast, Robertson does not describe a control means that is separate from a controller, as recited in the claim. Robertson merely describes a controller hub 100, a master counter 251, and a remote counter 252. Robertson, Abstract. Robertson is silent with regard to a control means apart from the controller hub 100 and the counters 251, 252, 7, 12, and 182. In particular, Robertson merely describes the controller hub 100 directly decrementing the master counter 251. Robertson, col. 7, lines 9-12. Additionally, Robertson expressly describes that the controller hub 100 directly checks the master counter 251. Robertson, col. 7, lines 64-66. Implementing the controller hub 100 to directly check, increment, and decrement the counters 251, 252, 7, 12, and 182 instead of offloading the checking, incrementing, and decrementing to a control means potentially takes away valuable processing resources from the controller hub 100. Therefore, Robertson does not teach control means for checking said first counter, checking said second counter, decrementing the count of said first counter, and

incrementing the count of said second counter because Robertson merely describes a controller hub to directly implement the functionality described in Robertson.

Furthermore, since Robertson fails to teach a control means, Robertson also fails to teach a control means adapted to issue a first call for available room in said FIFO memory to said controller. Moreover, even if the controller hub 100 were understood to describe the control means, Robertson does not teach the controller hub 100 issuing a first call for available room to itself.

For the reasons presented above, Robertson does not teach all of the limitations of the claim because Robertson does not teach control means which are separate from the controller hub. Hence, Robertson does not teach control means for checking said first counter, checking said second counter, decrementing the count of said first counter, and incrementing the count of said second counter, as recited in the claim. Additionally, the Office Action does not assert that Bender might teach the missing limitation of Robertson. Accordingly, Applicants respectfully assert that claim 1 is patentable over Robertson and Bender because Robertson does not teach "said control means is adapted to issue a first call for available room in said FIFO memory to said controller," as recited in claim 1.

Independent Claim 7

Applicants respectfully assert independent claim 7 is patentable over Robertson at least for similar reasons to those stated above in regard to the rejection of independent claim 1. In particular, claim 7 recites "issuing a first call for available room in said FIFO memory to said controller until there is room in said FIFO memory" (emphasis added).

Here, although the language of claim 7 differs from the language of claim 1 and the scope of claim 7 should be interpreted independently of claim 1, Applicants respectfully assert that the remarks provided above in regard to the rejection of claim 1 also apply to the rejection of claim 7. Additionally, the Office Action does not assert that Bender might teach the missing limitation of Robertson. Accordingly, Applicants respectfully assert claim 7 is patentable over Robertson and Bender because Robertson does not teach issuing a first call for available room in said FIFO memory to said controller until there is room in said FIFO memory.

Independent Claim 12

Applicants respectfully assert independent claim 12 is patentable over Robertson at least for similar reasons to those stated above in regard to the rejection of independent claim 1. In particular, claim 12 recites "said <u>control means is adapted to issue a second call</u> for available data elements in said FIFO memory <u>to said controller</u>" (emphasis added).

Here, although the language of claim 12 differs from the language of claim 1 and the scope of claim 12 should be interpreted independently of claim 1, Applicants respectfully assert that the remarks provided above in regard to the rejection of claim 1 also apply to the rejection of claim 12. Additionally, the Office Action does not assert that Bender might teach the missing limitation of Robertson. Accordingly, Applicants respectfully assert claim 12 is patentable over Robertson and Bender because Robertson does not teach control means for issuing a second call to a controller.

Independent Claim 18

Applicants respectfully assert independent claim 18 is patentable over Robertson at least for similar reasons to those stated above in regard to the rejection of independent claim 1. In particular, claim 18 recites "<u>issuing a second call for available data elements in said FIFO memory to said controller</u> until there is data element in said FIFO memory" (emphasis added).

Here, although the language of claim 18 differs from the language of claim 1 and the scope of claim 18 should be interpreted independently of claim 1, Applicants respectfully assert that the remarks provided above in regard to the rejection of claim 1 also apply to the rejection of claim 18. Additionally, the Office Action does not assert that Bender might teach the missing limitation of Robertson. Accordingly, Applicants respectfully assert claim 18 is patentable over Robertson and Bender because Robertson does not teach issuing a second call for available data elements in said FIFO memory to said controller until there is data element in said FIFO memory.

Dependent Claims

Claims 2-6, 8-11, 13-17, and 19-23 depend from and incorporate all of the limitations of the corresponding independent claims 1, 7, 12, and 18. Applicants respectfully assert claims 2-6, 8-11, 13-17, and 19-23 are allowable based on allowable base claims. Additionally, each of claims 2-6, 8-11, 13-17, and 19-23 may be allowable for further reasons, as described below.

In regard to claims 3-6 and 14-17, Applicants respectfully submit that claims 3-6 and 14-17 are patentable over Robertson and Bender because the combination of cited references does not teach all of the limitations of the claim. Each of claims 3-6 and 14-17 recite a control means. As explained above, Robertson fails to teach a control means in addition to a controller hub 100. Additionally, Bender fails to teach a control means in addition to a memory and switch management unit 27. More specifically, Bender fails to teach a control means to check a first counter, check a second counter, decrement the count of said first counter, and increment the count of said second counter, as described above. Accordingly, Applicants respectfully assert that claims 3-6 and 14-17 are patentable over Robertson and Bender because Robertson and Bender do not teach a control means as recited in claims 3-6 and 14-17.

CONCLUSION

Applicants respectfully request reconsideration of the claims in view of the amendments and remarks made herein. A notice of allowance is earnestly solicited.

At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account **50-3444** pursuant to 37 C.F.R. 1.25. Additionally, please charge any fees to Deposit Account **50-3444** under 37 C.F.R. 1.16, 1.17, 1.19, 1.20 and 1.21.

Respectfully submitted,

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